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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of Daylan B. Darby

Atty. Docket No: 42390.P11668

App. Serial No.: 09/880,488

Group Art Unit: 2154

Filed: 06/13/2001

Examiner: Hu, Jinsong

Title: ENCODED ELECTRONIC MAIL

Mail Stop: Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**BRIEF ON APPEAL**

Pursuant to Appellant's Notice of Appeal filed on September 1, 2006, Appellant presents this Brief and fee under 37 C.F.R. § 1.17(c) in appeal of the Final Rejection dated June 1, 2006.

**I. REAL PARTY IN INTEREST.**

Intel Corporation is the real party in interest.

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**II. RELATED APPEALS AND INTERFERENCES.**

There are no related appeals or interferences before the Board of Patent Appeals and Interferences known to Appellant, the Appellant's legal representatives, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. STATUS OF CLAIMS**

Claims 1-30 are pending in the application. Claims 1-30 stand finally rejected and are the claims subject to this appeal as are reproduced in Appendix A.

**IV. STATUS OF AMENDMENTS**

No amendments were filed after the Final Office Action dated June 1, 2006 (hereafter "Final Office Action").

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

Simply stated and generally speaking, embodiments of Appellant's invention are directed to a method an apparatus for encoded electronic mail that includes the files that represent the meta-data of an email. Typically, there are three steps to SMTP mail transactions. The transaction commences with a MAIL command that gives the sender identification. A series of one or more RCPT commands follows giving the receiver information. Then, a DATA command gives the mail data. Finally, the end of a mail data indicator confirms the transaction. The receiving computer then has a meta-file that

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contains the RFC821 instructions and at least a data file that contains the RFC822 header and body. (Specification, Page 3, lines 19-24)

As captured in independent Claims 1, 8, 13, 19 and 26, in various embodiments of the invention, the meta-data of an email is combined with the email data within a single file, and encoding (by means of a header) is implemented to monitor the changes to the meta-data and the location of the email data within the file. (Specification, Page 1, lines 4-8). Meta-data files contain information such as, but not limited to, email sender, email receiver(s), email file size, email forwarding, and processing information. (Specification, Page 2, lines 19-20). A format of the combined meta-file/data-file may comprise, for example, a fixed sized header that contains links or indices to the information within the file, including a link to the header size. The header may be expressed in any common syntax including, but not limited to, XML, HTML, and numeric offsets. The header links include a link to the start of the email data, a link to the email sender, a link to the email receiver(s), and the like. All the meta-data information may be similarly referenced, but not necessarily stored, in the header. (Specification, Page 4, lines 20-26).

Following the header is the actual email data which may be of variable length. Once recorded, the data portion does not change in size. Following the header and the actual email data is the variable meta-data information. Because email recipients are often aliased and forwarded and mailing lists are expanded, this variable meta-data information may change as the email is processed within the email system. (Specification, Page 4, line 27 – Page 5, line 1).

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**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The sole issue for consideration in this appeal is as follows:

- A. Whether Claims 1-30 are properly rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,651,087 ("Dennis").

**VII. ARGUMENTS**

A. **The Examiner failed to meet the burden of establishing a *prima facie* case of unpatentability**

As a preliminary matter, Appellant respectfully submits that the rejection of Claims 1-30 is facially deficient because the Examiner has not established a *prima facie* case of anticipation. As is well-established, in order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the cited prior art must disclose every limitation of the claims being rejected. Therefore, if even one claim element or limitation is not disclosed by the reference, a *prima facie* case is not established. Additionally, as the Federal Circuit has noted,

"As adapted to *ex parte* procedure, Graham [v. John Deere Co.] is interpreted as continuing to place the burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103."

*In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The Examiner thus has the burden of producing a factual basis for his rejection and for establishing unpatentability by identifying how each recited claim element is allegedly disclosed by

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the cited reference(s) or combination of references. The Examiner has failed to establish such a *prima facie* case (i.e., one based on factual basis) and has merely provided bare allegations that the claims are anticipated by Dennis. For example, with respect to the element of "[a second portion comprising a header with links to information capable of monitoring changes in the variable meta-data information], the information additionally capable of identifying a location of the electronic mail data within the electronic mail file", the Examiner cites (amongst a long list), the following section of Dennis (Dennis, Col. 1, line 65 – Col. 2, line 39):

"The present invention provides a computer-implemented method and system for communicating content intended for delivery to a recipient of an electronic mail message having an attached electronic file. The attached electronic file can be accessed in response to an input signal issued by an input device, such as a keyboard or pointing device, that is manipulated by the recipient of the electronic mail message. The identity of a remote server computer, such as a web site on an intranet or the global Internet, can be obtained in response to accessing the attached electronic file. The remote server computer publishes the content intended for communication to the email message recipient. This content can be displayed to the recipient by using the identity to establish a connection with the remote server. By providing the recipient of the electronic mail message with an automated mechanism for viewing the content at this identified remote server computer, the present invention eliminates the need to store this content within the attached file itself.

More particularly described, the present invention supports the communication of electronic content by using an electronic mail message to transport an electronic file attachment having instructions that, when executed by the recipient's computer, enable the recipient to view the electronic content by accessing a server computer identified by the electronic file attachment. In response to an input signal transmitted by a user's manipulation of an input device, the electronic file attachment is accessed by an electronic mail program. This electronic file attachment is typically opened for viewing within the viewing window of a document view program. For one aspect of the invention, the electronic file attachment contains a limited amount of content, such as a text-based instruction message, for viewing by the recipient within the viewing window. For example, a representative instruction message offers the recipient instructions on how to access a larger set of content by launching the electronic file attachment. In response to an input signal for launching the electronic file attachment, a browser program is launched to access content at a remote server computer identified by the attached file. This results in an automated transition from the electronic mail program environment to the browser program environment to support viewing of the content hosted at the remote server computer."

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Appellant fails to see any "factual basis" for suggesting that the section above discloses the claimed element. The Examiner simply restates the claim element with a string of cites (encompassing a large body of text), with no additional explanation for why the cite is relevant. This section of Dennis, pursuant to Appellant's own perusal, appears to be focused on "an electronic file attachments having instructions, that, when executed by the recipient's computer, enable the recipient to view the electronic content by accessing a server computer identified by the electronic file attachment." Appellant is simply at a loss to understand how this relates to the claimed elements.

The Examiner cites various other sections of Dennis without any explanation for why these section are relevant to the claim element (specifically, Dennis, Col. 3, line 3, line 5 - Col. 4line 3, Col., 6 lines 41-65 and Col 10, lines 47-62). These sections read as follows:

"The present invention provides a convenient and effective mechanism for communicating information with the assistance of an electronic mail system without sending this information as an attachment to an electronic mail message. A user of an electronic mail program can attach an electronic file containing a set of instructions, such as a computer routine or script, to an electronic mail message prior to transmitting that message to designated recipients. In response to receiving this electronic mail message, a recipient can open and view the message within his or her electronic mail program. Although this message typically contains a message body presenting text-based content, the message also includes an indicator indicating the presence of an electronic file attached to the message. In response to the recipient taking an action to access this attached file, the set of instructions contained in this file are executed by the recipient's computer. The execution of these instructions results in the launch of a browser program for viewing content at a web site identified by the attached file and connected to a distributed computer network, such as an intranet or the global Internet."

Dennis, Col. 3, line 50 - Col. 4, line 3.

"Turning now to FIG. 3, which illustrates the tasks completed at the decision block 210, an inquiry is conducted at step 305 to determine whether an input signal has been received by the electronic mail program to access a file attached to an electronic mail message. As shown in FIG. 3A, a display screen 320 presents a representative electronic mail message containing a header 325, a distribution list 330 identifying intended recipients, a text-based message body 335, and an electronic file 340 attached to

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the electronic mail message. The header 325 identifies the subject "Network Operations Solutions Group" of the electronic mail message and the creator or sender of the message, "Gary J. Dennis." The distribution list 330, identified as item 1 of the electronic mail message, is a list of intended recipients for the electronic mail message. The message body 335, identified as item 2, contains a message for viewing by the intended recipients upon receipt of the electronic mail message. The electronic file 340 is attached to the electronic mail message and is identified as item 3. For the representative example, the electronic file 340 is a binary file identified by the file name "NOSGJU.about.1.HTM." To access the attached file 340 in step 305, a user can position a position indicator, such as a cursor, proximate to the file 340 and transmit an input signal via an input device, typically by double-clicking a button on a pointing device, such as a mouse."

Dennis, Col. 6, lines 41-65

"Referring to Table 1, the header portion of the content of the electronic mail attachment is positioned between a pair of <head> HTML tags. The header contains the JavaScript language commands, highlighted in bold print, and positioned between a pair of <script> HTML tags. In response to executing the JavaScript commands, the browser program opens an additional view window to display the content published at the web site identified by "http://nosg.bst.bls.com/newlett/K2/indexcd.html". The next JavaScript command closes the browser window containing the initial instruction message from the viewer program associated with the electronic mail system. This leaves the browser with one open window containing the selected web site page. For this representative example, this address provides a link to the "Network Operations Solutions Group's NOSG News."

Dennis, Col. 10, lines 47-62

Again, Appellant submits that citation of these large sections of text, without any additional discussion or explanation, simply do not rise to the level of meeting the requisite burden of proof. Appellant respectfully submits that this argument was presented to the Examiner in the last filed amendment in this case, and despite that, the Examiner issued the Final Office Action with essentially the same text (i.e., with no additional explanation). Appellant therefore respectfully submits that the Examiner's failure to establish a *prima facie* case of anticipation renders this rejection improper and Appellant requests that the rejection of Claims 1-30 should be reversed for at least this reason.

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**B. Claims 1-30 are patentable over Dennis because Dennis fails to disclose critical aspects of the claims.**

Independent Claims 1, 8, 13, 19 and 26 are method and article claims directed to embodiments of the invention. As such, these claims all include similar elements of encoded electronic mail, namely the a first portion comprising a single file including combined electronic mail data and variable meta-data information, and a second portion comprising a header with links to information capable of monitoring changes in the variable meta-data information, the information additionally capable of identifying a location of the electronic mail data within the electronic mail file. The Examiner collectively rejected the independent claims based on the same rationale in the Final Office Action and Appellant shall therefore address the rejections to these claims collectively. Any reference hereafter to "the independent claims" shall encompass all the independent claims (Claims 1, 8, 13, 19 and 26).

The Examiner fails to show how Dennis discloses the elements in the independent claims of an electronic mail file that includes electronic ail data and variable meta-data information or a header with a link to information capable of monitoring changes in the variable meta-data information, where the information is additionally capable of identifying a location of the electronic mail data within electronic mail file. The Examiner cites various sections of Dennis to allegedly "show" this variable meta-data (specifically, "Message, Fig. 3", 335, Fig. 3 and 340, Fig. 3, Col. 2, lines 25-56 and col. 4, lines 4-17". First and foremost, Appellant respectfully reiterates that these bare allegations are simply insufficient for Appellant to truly address the Examiner's concerns. Additionally,



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Appellant's perusal of these sections simply does not support the Examiner's contention.

For example, Col. 2, lines 25-56 of Dennis reads as follows:

"This electronic file attachment is typically opened for viewing within the viewing window of a document view program. For one aspect of the invention, the electronic file attachment contains a limited amount of content, such as a text-based instruction message, for viewing by the recipient within the viewing window. For example, a representative instruction message offers the recipient instructions on how to access a larger set of content by launching the electronic file attachment. In response to an input signal for launching the electronic file attachment, a browser program is launched to access content at a remote server computer identified by the attached file. This results in an automated transition from the electronic mail program environment to the browser program environment to support viewing of the content hosted at the remote server computer.

Prior to the advent of the present invention, a user of an electronic mail program would have forwarded content of interest to the recipient of the electronic mail message within the body of an electronic mail attachment. The present invention enables the user to post content at a remote server computer and to send an electronic mail attachment containing instructions (rather than lengthy content) that command the recipient's computer to identify and access this content at the remote server computer. By accessing the electronic mail attachment, instructions contained in this attached file are executed to support the presentation by a browser program of content maintained at the identified remote server computer. The attached file can include an identifier, such as an address or link for a web site, that identifies a storage mechanism other than the electronic mail attachment for the content intended for delivery to the recipient of the electronic mail message."

This scheme in Dennis is further articulated in the next section of Dennis highlighted by the Examiner, namely Col. 4, lines 4-17, which reads as follows:

"The browser program can display the content for a predetermined web site identified by an address provided to the browser program in response to execution of the instruction set maintained by the electronic mail attachment. For example, this address can be a uniform resource locator (URL) or location identifier for a particular page of content at the predetermined web site. In this manner, accessing an electronic file attached to an electronic mail program results in the automated presentation of content posted at a web site identified by that electronic file. From the view of the electronic mail message recipient, this transition between the electronic mail program environment and the browser program environment is completed without manual interaction."

Appellant fails to see how this section of Dennis is relevant to the claimed invention.

All these sections appear to describe that Dennis "enables the user to post content at a remote server computer and to send an electronic mail attachment containing instructions

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(rather than lengthy content) that command the recipient's computer to identify and access this content at the remote server computer (Dennis, Col. 2, lines 43-47). This type of scheme does not resemble the claimed invention. Nothing in these sections discloses the claimed elements. As discussed in the Specification and claimed in independent Claims 1, 8, 13, 19 and 26, electronic mail files according to embodiments of the invention include both mail data and variable meta-data as well as a *header with a link to information capable of monitoring changes in the variable meta-data information, where the information is additionally capable of identifying a location of the electronic mail data within electronic mail file*. The electronic mail file in Dennis does not disclose these elements (e.g., a header with a link to the requisite information or information capable of identifying a location of the electronic mail data within the electronic mail file).

The Examiner points to Col. 1, line 65 – Col. 2, line 39, Col. 3, line 3, line 50 – Col. 4 line 3, Col., 6 lines 41-65 and Col 10, lines 47-62 as allegedly showing this element, but Appellant strongly disagrees. First and foremost, the Examiner's statements are purely conclusory, with no factual basis for how these sections disclose the elements. Additionally, even given its broadest interpretation, Appellant still does not see how these sections are relevant to showing the claimed elements. Col. 1, line 65 – Col. 2, line 39, Col. 3, line 3, line 50 – Col. 4 line 3, Col., 6 lines 41-65 and Col 10, lines 47-62 are all recited in their entirety above and as previously discussed, no explanation is provided by the Examiner to aid understanding of the relevance of this section. As a result, relying on Appellant's own reading, Appellant respectfully submits that nothing in these sections disclose the claimed element.

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As previously discussed, all these sections appear to simply reiterate the scheme in Dennis which "enables the user to post content at a remote server computer and to send an electronic mail attachment containing instructions (rather than lengthy content) that command the recipient's computer to identify and access this content at the remote server computer" (e.g., Dennis, Col. 2, lines 43-47). None of these sections, however, actually disclose the claimed elements of (i) a header with a link to information capable of monitoring changes in the variable meta-data information, (ii) where the information is additionally capable of identifying a location of the electronic mail data within electronic mail file.

In summary, Appellant respectfully submits that the Examiner failed to establish a *prima facie* case of anticipation and that Appellant's own perusal of Dennis shows no indication that Dennis anticipates Claims 1-30. As such, Appellant respectfully submits that the Examiner has failed to meet his burden of proof to render Claims 1-30 anticipated by Dennis and Appellant requests the rejection to these claims to be reversed for at least the reasons discussed above.

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**VIII. CONCLUSION**

It is respectfully submitted that in view of the foregoing, all of the pending claims (Claims 1-30) are patentable over the cited prior art references, alone or in any combination, and the Board is respectfully requested to overturn the rejections of record and allow this application to issue.

Respectfully submitted,

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#### APPENDIX A

1. (Previously presented) A data structure for an electronic mail file comprising:  
a first portion comprising a single file including combined electronic mail data and variable meta-data information; and  
a second portion comprising a header with links to information capable of monitoring changes in the variable meta-data information, the information additionally capable of identifying a location of the electronic mail data within the electronic mail file.
2. (Original) The data structure of claim 1, wherein the header includes a link to a start of the electronic mail data.
3. (Original) The data structure of claim 1, wherein the header includes a link to an electronic mail sender.
4. (Original) The data structure of claim 1, wherein the header includes a link to an electronic mail recipient.
5. (Original) The data structure of claim 1, wherein the header operates as an encoder and monitors changes to the variable meta-data information.
6. (Original) The data structure of claim 1, wherein the header operates as an encoder and monitors a location of the electronic mail data within the file.
7. (Original) The data structure of claim 1, wherein the meta-data information is referenced in the header.
8. (Previously presented) A method of encoding electronic mail comprising:

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combining into a single electronic mail file electronic mail data and  
variable meta-data information;  
monitoring changes to the meta-data information with a header; and  
monitoring a location of the electronic mail data within the electronic mail  
file with the header.

9. (Original) The method of claim 8, wherein the electronic mail data is of  
variable length when unrecorded and is of fixed length when recorded.

10. (Original) The method of claim 8, wherein the meta-data information is  
referenced in the header.

11. (Original) The method of claim 8, wherein the header operates as an  
encoder.

12. (Original) The method of claim 8, wherein the header contains links to a  
start of the electronic mail data, to an electronic mail sender, and to an electronic  
mail recipient.

13. (Previously presented) A computer readable medium having computer  
readable instructions encoded therein to:

accept an electronic mail connection;  
receive a single electronic mail file comprising electronic mail data  
combined with meta-data information, the single electronic mail file  
further comprising a header with links to the meta-data information  
and a location of the electronic mail data;  
record the electronic mail data;  
compute and record the meta-data information;  
compute and record links within the header; and

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pass the electronic mail file containing the electronic mail data and the meta-data information for processing.

14. (Original) The computer readable medium of claim 13, wherein the electronic mail data is of variable length when unrecorded and is of fixed length when recorded.
15. (Original) The computer readable medium of claim 13, wherein the meta-data information is referenced in the header.
16. (Original) The computer readable medium of claim 13, wherein the header links include links to a start of the electronic mail data, to an electronic mail sender, and to an electronic mail recipient.
17. (Original) The computer readable medium of claim 13, wherein the header is used to monitor changes to the meta-data information.
18. (Original) The computer readable medium of claim 13, wherein the header is used to monitor a location of the electronic mail data within the file.
19. (Previously presented) A computer readable medium having computer readable instructions encoded therein to:
  - open a single electronic mail file containing combined electronic mail data and meta-data information, the single electronic mail file further comprising a header with links to the meta-data information and a location of the electronic mail data;
  - recompute the meta-data information;
  - attempt delivery of the electronic mail file;
  - rewrite the meta-data information;
  - change the links contained within the header; and

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close the electronic mail file.

20. (Original) The computer readable medium of claim 19, wherein the electronic mail data is of variable length when unrecorded and is of fixed length once recorded.

21. (Original) The computer readable medium of claim 19, wherein the meta-data information is referenced in the header.

22. (Original) The computer readable medium of claim 19, wherein the header includes links to a start of the electronic mail data, to an electronic mail sender, and to an electronic mail recipient.

23. (Original) The computer readable medium of claim 19, wherein the header operates as an encoder.

24. (Original) The computer readable medium of claim 23, wherein the header monitors changes to the meta-data information.

25. (Original) The computer readable medium of claim 23, wherein the header monitors a location of the electronic mail data within the file.

26. (Previously presented) A method of providing an single electronic mail file from a sending computer to at least one receiving computer within a data communication network comprising:

- establishing a simple mail transfer protocol (SMTP) session between the sending computer and the at least one receiving computer;
- generating commands by the sending computer;
- sending the commands to the at least one receiving computer; and



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sending replies from the at least one receiving computer to the sending computers  
wherein the single electronic mail file includes combined electronic mail data and variable meta-data information and a header containing links to the meta-data information and to a location of the electronic mail data within the electronic mail file.

27. (Original) The method of claim 26, wherein the data communication network includes an Internet or Intranet.
28. (Original) The method of claim 26, wherein the header includes a link to a start of the electronic mail data, to an electronic mail sender, and to an electronic mail recipient.
29. (Original) The method of claim 26, wherein the header monitors changes to the meta-data information and monitors a location of the electronic mail data within the file.
30. (Original) The method of claim 26, wherein the meta-data information is referenced in the header.

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**EVIDENCE APPENDIX**

None

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**RELATED PROCEEDINGS APPENDIX**

None